



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/763,007

01/21/2004

Todd A. Walker

UV-258

6197

75563 7590 10/06/2008

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

CHIN, RICKY

ART UNIT

PAPER NUMBER

2423

MAIL DATE

DELIVERY MODE

10/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/763,007	Applicant(s) WALKER, TODD A.	
	Examiner RICKY CHIN	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed July 17, 2008 have been fully considered but they are not persuasive.

Applicant argues that Srinivasan et al. do not teach of a streaming version of the broadcast program. Applicant argues this by citing paragraph 0008 which states that "these solutions do not require copying or redundantly storing the streamed data, thereby avoiding unnecessary use of resources". However, paragraph 0008 only emphasizes the presence of a streaming data version of the broadcast program as the streamed data referred to in the paragraph is in reference to the streaming data recorded version of the broadcasting program and not the broadcast stream as applicant insists. Redundantly storing and copying of *the recorded data stream version* of the broadcasting program is not required. Furthermore, paragraph 0003 discloses of a broadcast stream and the recording of the broadcast stream and being able to playback the recorded stream at any speed. Thus, it consists of a broadcast stream and a streaming version of the broadcast stream in order for time shifting to occur. Also refer to paragraphs 0009-0011 which also disclose the recording of the broadcast stream of data into a stored streaming version in order for providing trick play.

Applicant also argues that Dunn et al. do not teach generating a streaming version of the broadcast program before the broadcast of the television. The examiner respectfully disagrees. VOD programs consist of full length content

Art Unit: 2623

program such full length movie, video game or past TV shows which are stored for viewing at anytime (See Dunn, col. 4 lines 53-67). Hence, these streaming versions of programs are generated before the broadcast of *any* program being broadcast since they are stored which meets the claim limitation of a streaming version of the broadcast television being generated before the broadcast of the television program. Thus, when the broadcast program is available for VOD as well, the streaming version is always generated before the broadcast of the program.

Applicant also argues that there is no motivation to combine Srinivasan with Dunn et al. because Srinivasan et al. teach away from using any other data with a broadcast program. Applicant argues this by citing paragraph 0008 stating that “these solutions do not require copying or redundantly storing the streamed data”. However, as discussed above it does not require copying or redundantly storing the streamed (recorded) data. A streaming version of the broadcasted programming is still provided as the program is recorded as stored files of the broadcast data stream in order to facilitate trick play as described in paragraphs 0003 and paragraphs 0008-0011 as described above. Thus, Srinivasan and Dunn both consist of a streaming version and motivation for facilitating trick play.

Regarding newly added claims 57-60, the rejections are provided below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims (1-2, 6, and 13) are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al., US 2002/0124099 in view of Dunn et al., US 6,571,390.

Regarding claim 1, Srinivasan discloses a method for providing a user with playback options while viewing a broadcast television program on user equipment (See [0003], which discloses time shifting allowing a user to pause a live broadcast), the method comprising: providing the broadcast television program to the user equipment (See [0028]); receiving a request from the user to perform a playback option while viewing the television program that is currently being broadcast (See [0003], which discloses that time shifting allows a user to pause a live broadcast as well as seek forward and backward through a stream) ; and providing a streaming version of the broadcast television program to the user equipment instead of the broadcast television program in response to the received request (See [0008]-[0011], which discloses creating overlapped recordings of a data stream allowing a user to record an entire program as well

Art Unit: 2623

as one or more portions of the program and access them independently of one another).

However, Srinivasan doesn't explicitly teach of the method of wherein in the streaming version of the broadcast television program is generated before the broadcast of the television program. Dunn discloses a VOD system which provides a streaming version that is generated before the broadcast of the television program (See col. 4 lines 53-67, which discloses that headend 22 provides video content programs which a viewer can select any one of the video data streams for viewing at any time).

Therefore it would have been obvious of one of ordinary skill in the art to have combined the teachings of Srinivasan with that of Dunn for the mere benefit of providing increased flexibility of playback options and the option of being able to watch a program at ones own leisure.

Regarding claim 2, Dunn further teaches of charging the user a fee when the user requests to perform the playback option (See col. 11 lines 58-62, which discloses a rental period).

Regarding claim 6, Dunn further teaches of wherein the generated streaming version of the broadcast television program is substantially the same as the broadcast television program (See col. 3 lines 22-40, which discloses that the viewer can order a video for a rental period. Furthermore, if the user were to

Art Unit: 2623

order the video of the same broadcast television program then the generated streaming version would be substantially the same as the broadcast program).

Regarding claim 13, the claim has been analyzed and rejected for the same reasons set forth in claim 6.

4. Claims (3-5, 7-12, 14) are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al., US 2002/0124099 in view of Dunn et al., US 6,571,390 as applied to claim 1 above and in further view of Ellis et al., US 2002/0174430.

Regarding claim 3, Srinivasan and Dunn when combined teach all of the claim limitations of claim 1. However, they do not explicitly teach of receiving a request from the user to return to the broadcast of the broadcast television program. Ellis discloses this feature (See [0292], which states that live television programming may be buffered when a recording is canceled or completed). Therefore it would have been obvious of one of ordinary skill in the art at the time of the invention to have combined the teachings of Srinivasan and Dunn with that of Ellis for the mere benefit of increased flexibility of playback and allowing a user to return back to live television.

Regarding claim 4, the claim has been analyzed and rejected for the same reasons set forth in the rejection of claim 3.

Art Unit: 2623

Regarding claim 5, Srinivasan, Dunn and Ellis in combination further teaches of automatically returning to the broadcast of the broadcast television program after a predetermined amount of time (Ellis [0289], which discloses scheduled recording implying a predetermined amount of time and would be able to automatically return to the broadcast as recited in claims 3 and 4).

Regarding claim 7, Srinivasan, Dunn and Ellis in combination further teaches of wherein the playback option is selected from the group consisting of: pause, resume, play, fast forward, rewind, slow forward, slow reverse, jump to another time point, scan, frame-by-frame advance, frame backward, skip, and restart program (Ellis, [0018], which discloses functions of fast-forward, rewind, stop, play, record, and other suitable functions).

Regarding claim 8, Srinivasan, Dunn and Ellis in combination further teaches of wherein providing the streaming version comprises determining the time point in the broadcast television program at which the user requests to perform the playback option (Ellis, [0018], which discloses that the application may display paused video of the television content and display a timer showing how far back the paused video is behind the live content. This would imply that the time point in the broadcast at which the user requests playback is retrieved).

Regarding claim 9, Srinivasan, Dunn and Ellis in combination further teaches of wherein the providing the streaming version further comprises

Art Unit: 2623

providing the streaming version of the television program at substantially the same time point (Srinivasan, [0038], which discloses that the system can seamlessly switch between metafiles in response to stored data and user commands).

Regarding claim 10, the claim has been analyzed and rejected for the same reasons set forth in the rejection of claim 8.

Regarding claim 11, Srinivasan, Dunn and Ellis in combination further teaches of wherein the broadcast television program is associated with an index of time points, and wherein the determining the time point comprises using the associated index to determine the time point at which the user requests to perform the playback option (Srinivasan, [0035]-[0039], which discloses metafiles which include data portions such as minutes of a broadcast).

Regarding claim 12, Srinivasan, Dunn and Ellis in combination further teaches of wherein the associated index includes a plurality of embedded markers in the broadcast television program, and wherein the using the associated index comprises determining the time point corresponding to the embedded marker at which the user requests to perform the playback option (Srinivasan, [0039], which discloses that each metafile includes pointers to the appropriate media files and particular time within each media file that represent the relevant portion of the television broadcast).

Regarding claim 14, Srinivasan, Dunn and Ellis in combination further teaches of wherein the providing the streaming version includes detecting at least one embedded marker (Srinivasan, [0035]-[0041]).

Regarding claims 15-16,20,27,29-30,34,41,43-44,48, and 55 the claims have substantially the same subject matter as claims 1,2,6 and 13 and thus have been rejected for the same reasons set forth in the above rejected claims.

Regarding claims 17-19,21-26,28,31-33,35-40,42,45-47,49-54, and 56 the claims have substantially the same subject matter as claims 3-5,7-12, and 14 and thus have been rejected for the same reasons set forth in the above rejected claims.

5. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al., US 2002/0124099 in view of Dunn et al., US 6,571,390, and in further view of Dow et al., Us 2004/0221311.

Regarding claims 57-60, the combination of Srinivasan and Dunn teach all of the claim limitations of claims 1, 15, 29, and 43. The combination does not explicitly teach of a playback option which includes playing the streaming version of the broadcast television programming starting at the beginning of the program. However, in the same field of endeavor, Dow discloses of a Play from Beginning

Art Unit: 2623

option (See Fig. 4, 424). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Srinivasan and Dunn to incorporate a playback option to start from the beginning of the streamed program as taught by Dow as to provide convenience to a viewer desiring to start from the beginning of a program so that the complete program may be watched.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2623

Contact

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky Chin whose telephone number is 571-270-3753. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on 571-272-7296. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ricky Chin/
Patent Examiner
AU 2623
(571) 270-3753
Ricky.Chin@uspto.gov

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2623